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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/711,611

09/28/2004

Tatsuya Kawakami

SIC-04-032

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DELAND LAW OFFICE

P.O. BOX 69

KLAMATH RIVER, CA 96050-0069

EXAMINER

LUONG, VINH

ART UNIT

PAPER NUMBER

3682

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,611	<b>Applicant(s)</b> KAWAKAMI, TATSUYA	
	<b>Examiner</b> Vinh T. Luong	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/17/08; 11/10/06; 9/28/04</u>                                | 6) <input type="checkbox"/> Other: _____                          |

1. Applicant's election of the species of FIGS. 5-6B in the reply filed on January 16, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. Claim 22 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 16, 2008.

3. The drawings were received on January 16, 2008. These drawings are accepted by the Examiner.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Campagnolo (US Patent No. 5,806,372).

Regarding Claim 1, Campagnolo teaches an apparatus for reducing an engaging force of an engaging member for a bicycle component comprising: a first engaging member 20/31; a movable second engaging member 22/32; wherein the first engaging member 20/31 engages the second engaging member 22/32; and a biasing mechanism 23/29 that applies a biasing force to bias the first engaging member 20/31 and the second engaging member 22/32 towards each other, wherein the biasing mechanism 23/29 reduces the biasing force when the second engaging member 22/32 moves. *Ibid.* col. 3, line 38+ and Claims 1-3.

Claim 1 and other claims below are anticipated by Campagnolo because Campagnolo teaches each and every positively claimed element in the claim. As noted, the “wherein” or “whereby” clause that merely states the inherent results of limitations in the claim adds nothing to the claim’s patentability or substance. *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); and *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Regarding Claim 2, the biasing mechanism 23/29 applies the biasing force to at least one of the first engaging member 20/31 and the second engaging member 22/32 at a biasing location, and wherein the biasing mechanism applies the biasing force to a different biasing location to reduce the biasing force when the second engaging member 22/32 moves as seen in FIG. 2.

Regarding Claim 3, the second engaging member 22/32 comprises a positioning unit 22/32 for a bicycle shift control device 10, 11 (FIG. 1).

Regarding Claim 4, the first engaging member 20/31 comprises a positioning member 20/31 that engages the positioning unit 22/32 to maintain the positioning unit 22/32 in a selected position.

Regarding Claim 5, the biasing mechanism 23/29 applies the biasing force to the positioning member 20/31.

Regarding Claim 6, one of the positioning member 20/31 and the biasing mechanism 23/29 moves relative to the other one of the positioning member 20/31 and the biasing mechanism 23/29 to reduce the biasing force when the positioning unit 22/32 moves.

Regarding Claim 7, the positioning member 20/31 moves or is capable of moving in response to movement of the positioning unit 22/32.

Regarding Claim 8, the positioning member 20/31 moves or is capable of moving relative to the biasing mechanism 23/29 when the positioning unit 22/32 moves so that the biasing mechanism 23/29 applies the biasing force to the different biasing location.

Regarding Claim 9, the positioning member 20/31 moves or is capable of moving together with the positioning unit 22/32 when the positioning unit 22/32 moves.

Regarding Claim 10, the movement of the positioning member 20/31 causes the biasing mechanism 23/29 to apply the biasing force to the different biasing location.

Regarding Claim 11, the positioning unit 22/32 comprises a plurality of positioning teeth 22/32, and wherein the positioning member 20/31 comprises a positioning pawl 20/31 that engages selected ones of the plurality of positioning teeth 22/32 to maintain the positioning unit 22/32 in the selected position.

Regarding Claim 12, the positioning unit 22/32 and the positioning pawl 20/31 move relative to each other so that the positioning pawl 20/31 moves over at least one of the plurality of positioning teeth 22/32, and wherein the biasing mechanism 23/29 applies the biasing force to the different biasing location so that the biasing force is reduced when the positioning member 20/31 moves over the at least one of the plurality of positioning teeth 22/32.

Regarding Claim 13, the biasing mechanism 23/29 increases or is capable of increasing the biasing force to the positioning member 20/31 after the positioning member 20/31 moves over the at least one of the plurality of positioning teeth 22/32.

Regarding Claim 14, the biasing mechanism 23/29 applies or is capable of applying the biasing force to substantially the same biasing location before and after the positioning member 20/31 moves over the at least one of the plurality of positioning teeth 22/32.

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Regarding Claim 15, the positioning pawl 20/31 moves or is capable of moving relative to the biasing mechanism 23/29 when the positioning unit 22/32 moves so that the biasing mechanism 23/29 applies the biasing force to the different biasing location.

Regarding Claim 16, the positioning pawl 20/31 moves or is capable of moving together with the positioning unit 22/32 when the positioning unit 22/32 moves.

Regarding Claim 17, the movement of the positioning member 20/31 inherently causes the biasing mechanism 23/29 to apply the biasing force to the different biasing location.

Regarding Claim 18, see a mounting member 24 that supports the positioning unit 22/32 and the positioning pawl 20/31, and wherein the biasing mechanism 23/29 is secured relative to the mounting member 24.

Regarding Claim 19, the positioning unit 22/32 rotates or is capable of rotating to move the positioning pawl 20/31.

Regarding Claim 20, the biasing mechanism 23/29 comprises a spring 23/29.

Regarding Claim 21, the biasing mechanism 23/29 comprises a coil spring 23/29.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Juy (spring 12), Shimada (spring 14), Nagano (spring 33), Smolik (spring 20), Blaschke (pawls 8-11 urged by the spring), Nagano (spring 102), and Konishi (spring 7).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/

Primary Examiner, Art Unit 3682